



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/303,561	09/09/94	BEDNORZ	J Y0987074BY

DANIEL P MORRIS
IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
P O BOX 218
YORKTOWN HEIGHTS NY 10598

IM51/0225

EXAMINER	
KOPEC, M	
ART UNIT	PAPER NUMBER
1751	77A

DATE MAILED:

02/25/99

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- ☒ is extended to run 6 mos. from the date of the Final Rejection
- ☐ continues to run _____ from the date of the Final Rejection
- ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 12/18/98, has been considered with the following affect, but it is not deemed to place the application in condition for allowance: 12/23/98

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - ☐ They raise new issues that would require further consideration and/or search. (See Note).
 - ☐ They raise the issue of new matter. (See Note).
 - ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The terminology "layer-type" or "perovskite-like" has been rejected under 35 USC 112, 2nd TP, since at least the REJECTION mailed 8/26/92. The newly filed exhibits are considered untimely.

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☐ Upon the filing of an appeal, the proposed amendment ☐ will be ☐ will not be, entered and the status of the claims in this application would be as follows:
- Allowed claims: _____
- Claims objected to: _____
- Claims rejected: _____
- However;
- ☐ The rejection of claims _____ on references is deemed to be overcome by applicant's response.
 - ☐ The rejection of claims _____ on non-reference grounds only is deemed to be overcome by applicant's response.
4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection.
5. ☒ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented. SEE NOTE
- ☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.
- ☐ Other

Mark Kopec

Mark Kopec
Primary Examiner



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Patent and Trademark Office

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Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/303,561	09/09/94	BEDNORZ	J Y0987074BY

DANIEL P MORRIS
IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
P O BOX 218
YORKTOWN HEIGHTS NY 10598

IM51/0225

EXAMINER	
KOPEC, M	
ART UNIT	PAPER NUMBER
1751	778

DATE MAILED:

02/25/99

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

☒ is extended to run 6 mos. from the date of the Final Rejection

☐ continues to run _____ from the date of the Final Rejection

☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 12/15/98, has been considered with the following affect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

- ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- ☐ They raise new issues that would require further consideration and/or search. (See Note).
- ☐ They raise the issue of new matter. (See Note).
- ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The 112, 1st P, rejections directed to enablement, to which the newly submitted affidavit pertains, have been of record since at least 8/26/92. The newly filed affidavit is considered untimely.

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☐ Upon the filing of an appeal, the proposed amendment ☐ will be ☐ will not be, entered and the status of the claims in this application would be as follows:

Allowed claims: _____

Claims objected to: _____

Claims rejected: _____

However;

a. ☐ The rejection of claims _____ on references is deemed to be overcome by applicant's response.

b. ☐ The rejection of claims _____ on non-reference grounds only is deemed to be overcome by applicant's response.

4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection.

5. ☒ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented. SEE NOTE.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

Mark Kopec

Mark Kopec
Primary Examiner

08/303.561

09/09/94

BED 15123225


**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

 DANIEL F MORRIS
IBM CORPORATION

INTELLECTUAL PROPERTY LAW DEPARTMENT

SERIAL NUMBER P O BOX 218	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO. 02725799
YORKTOWN HEIGHTS NY 10598			

EXAMINER	
ART UNIT	PAPER NUMBER
	77c

DATE MAILED:

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION☒ THE PERIOD FOR RESPONSE:

- ☒ is extended to run 6 mos from the date of the Final Rejection
- ☐ continues to run _____ from the date of the Final Rejection
- ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).☒ Applicant's response to the final rejection, filed 12/14/98, has been considered with the following affect, but it is not deemed to place the application in condition for allowance:1. ☒ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☒ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: Newly added claims 143-177 do not simplify or reduce issues for appeal. The amendments to claims 115-142, which overcome several 112, 2nd TP, rejections of record, will be entered if submitted separately.

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.3. ☒ Upon the filing of an appeal, the proposed amendment ☐ will be ☒ will not be, entered and the status of the claims in this application would be as follows:Allowed claims: 136

Claims objected to: _____

Claims rejected: 24-26, 86-90, 96-135, 137-142

However;

- a. ☐ The rejection of claims _____ on references is deemed to be overcome by applicant's response.
- b. ☐ The rejection of claims _____ on non-reference grounds only is deemed to be overcome by applicant's response.

4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection.5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.☐ Other

Mark Kopec
Mark Kopec
Primary Examiner



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Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/303,561	09/09/94	BEDNORZ	J Y0987074BY

IM51/0225

DANIEL P MORRIS
IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
P O BOX 218
YORKTOWN HEIGHTS NY 10598

EXAMINER	
KOPEC, M	
ART UNIT	PAPER NUMBER
1751	770
DATE MAILED: 02/25/99	

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

☒ is extended to run 6 mos from the date of the Final Rejection

☐ continues to run _____ from the date of the Final Rejection

☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 12/24/98, has been considered with the following affect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

- ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- ☐ They raise new issues that would require further consideration and/or search. (See Note).
- ☐ They raise the issue of new matter. (See Note).
- ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The terminology "perovskite-like" and "rare-earth like" have been rejected under 35 USC 112, 2nd JP, since it lacks the REJECTION mailed 8/26/92. The newly filed exhibits are considered untimely.

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☐ Upon the filing of an appeal, the proposed amendment ☐ will be ☐ will not be, entered and the status of the claims in this application would be as follows:

Allowed claims: _____

Claims objected to: _____

Claims rejected: _____

However;

a. ☐ The rejection of claims _____ on references is deemed to be overcome by applicant's response.

b. ☐ The rejection of claims _____ on non-reference grounds only is deemed to be overcome by applicant's response.

4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection.

5. ☒ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented. SEE NOTE

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

Mark Kopec
Primary Examiner



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Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/303,561	09/09/94	BEDNORZ	J Y0987074BY

DANIEL P MORRIS
IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
P O BOX 218
YORKTOWN HEIGHTS NY 10598

IM51/0225

EXAMINER	
KOPEC, M	
ART UNIT	PAPER NUMBER
1751	77E

DATE MAILED:

02/25/99

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

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- ☐ continues to run _____ from the date of the Final Rejection
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Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 12/16/98, has been considered with the following affect, but it is not deemed to place the application in condition for allowance: 12/24/98

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - ☐ They raise new issues that would require further consideration and/or search. (See Note).
 - ☐ They raise the issue of new matter. (See Note).
 - ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☐ Upon the filing of an appeal, the proposed amendment ☐ will be ☐ will not be, entered and the status of the claims in this application would be as follows:

Allowed claims: _____

Claims objected to: _____

Claims rejected: _____

However;

- a. ☐ The rejection of claims _____ on references is deemed to be overcome by applicant's response.
- b. ☐ The rejection of claims _____ on non-reference grounds only is deemed to be overcome by applicant's response.

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection. SEE ATTACH

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

Mark Kopec

Mark Kopec
Primary Examiner

Art Unit: 1751

The additional 1.132 Affidavits of Mitzi, Tsuei and Dinger (filed 12/16/98) and the newly provided 1.132 Affidavits of Thomas Shaw (filed 12/16/98) and Peter Duncombe (filed 12/21/98) have been reviewed and considered.

The examiner notes the books describing the general principles of ceramic fabrication provided in these Affidavits. Also, the examiner notes that such fabrication techniques were utilized subsequently (after the filing date of the instant application) to produce the superconductive materials described in the Poole et al reference as well as the materials produced by Peter Duncombe (see Affidavit filed 12/21/98).

It is the examiner's maintained position that while general principles of ceramic fabrication were most certainly known prior to the filing date of the instant application, the utilization of such techniques to produce superconductive materials within the scope of the instant claims were not known. The affidavits are not effective to demonstrate enablement *at the time* the invention was made. As stated in paper #66, page 8, one may *now* know of a material that superconducts at more than 26K, but the affidavits do not establish the existence of that knowledge on the filing date of the present application.

Application/Control Number: 08/303,561

Art Unit: 1751

It is acknowledged that applicants are pioneers in the filed of high temperature metal oxide superconductivity. The examiner respectfully maintains, for the reasons of record, that the disclosure is not fully enabling for the scope of the present claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Kopec whose telephone number is (703) 308-1088. The examiner can normally be reached on Monday-Thursday from 7:30 AM - 6:00 PM.

If reasonable attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.


Mark Kopec
Primary Examiner

Mark Kopec
February 22, 1999